

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

MINERVA INDUSTRIES, INC.,

Plaintiff,

vs.

MOTOROLA, INC., *et al.*,

Defendants

Case No. 2:07-cv-00229-TJW

ANSWER AND COUNTERCLAIMS OF
PANTECH WIRELESS, INC. TO
MINERVA'S COMPLAINT

JURY TRIAL DEMANDED

**PANTECH WIRELESS, INC.'S ANSWER, AFFIRMATIVE DEFENSES,
AND COUNTERCLAIMS TO MINERVA'S COMPLAINT**

Defendant Pantech Wireless, Inc. ("Pantech"), by and through its undersigned counsel, respectfully submits its Answer, Affirmative Defenses, and Counterclaims in response to plaintiff Minerva Industries, Inc.'s ("Minerva") Complaint For Patent Infringement ("Complaint") as follows:

The Parties

1. Pantech lacks knowledge or information sufficient to admit or deny the allegations of the Complaint, and on that basis, denies the same.

2. Pantech lacks knowledge or information sufficient to admit or deny the allegations of the Complaint, and on that basis, denies the same.

3. Pantech lacks knowledge or information sufficient to admit or deny the allegations of the Complaint, and on that basis, denies the same.

1 4. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
2 the Complaint, and on that basis, denies the same.

3 5. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
4 the Complaint, and on that basis, denies the same.

5 6. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
6 the Complaint, and on that basis, denies the same.

7 7. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
8 the Complaint, and on that basis, denies the same.

9 8. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
10 the Complaint, and on that basis, denies the same.

11 9. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
12 the Complaint, and on that basis, denies the same.

13 10. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
14 the Complaint, and on that basis, denies the same.

15 11. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
16 the Complaint, and on that basis, denies the same.

17 12. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
18 the Complaint, and on that basis, denies the same.

19 13. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
20 the Complaint, and on that basis, denies the same.

21 14. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
22 the Complaint, and on that basis, denies the same.

23 15. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
24 the Complaint, and on that basis, denies the same.

1 16. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
2 the Complaint, and on that basis, denies the same.

3 17. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
4 the Complaint, and on that basis, denies the same.

5 18. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
6 the Complaint, and on that basis, denies the same.

7 19. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
8 the Complaint, and on that basis, denies the same.

9 20. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
10 the Complaint, and on that basis, denies the same.

11 21. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
12 the Complaint, and on that basis, denies the same.

13 22. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
14 the Complaint, and on that basis, denies the same.

15 23. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
16 the Complaint, and on that basis, denies the same.

17 24. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
18 the Complaint, and on that basis, denies the same.

19 25. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
20 the Complaint, and on that basis, denies the same.

21 26. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
22 the Complaint, and on that basis, denies the same.

23 27. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
24 the Complaint, and on that basis, denies the same.

1 28. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
2 the Complaint, and on that basis, denies the same.

3 29. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
4 the Complaint, and on that basis, denies the same.

5 30. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
6 the Complaint, and on that basis, denies the same.

7 31. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
8 the Complaint, and on that basis, denies the same.

9 32. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
10 the Complaint, and on that basis, denies the same.

11 33. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
12 the Complaint, and on that basis, denies the same.

13 34. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
14 the Complaint, and on that basis, denies the same.

15 35. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
16 the Complaint, and on that basis, denies the same.

17 36. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
18 the Complaint, and on that basis, denies the same.

19 37. Admitted.

20 38. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
21 the Complaint, and on that basis, denies the same.

22 39. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
23 the Complaint, and on that basis, denies the same.

24 40. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
25 the Complaint, and on that basis, denies the same.

1 41. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
2 the Complaint, and on that basis, denies the same.

3 42. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
4 the Complaint, and on that basis, denies the same.

5 43. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
6 the Complaint, and on that basis, denies the same.

7 44. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
8 the Complaint, and on that basis, denies the same.

9
10 **Jurisdiction and Venue**

11 45. Pantech admits that this Court has subject matter jurisdiction pursuant to 28 U.S.C. §§
12 1331 and 1338(a) over actions arising under the patent laws of the United States.

13 46. Pantech lacks knowledge or information sufficient to form a belief as to whether
14 venue is proper as to Pantech in this district pursuant to 28 U.S.C. §§ 1391(b) and (c) and
15 1400(b), and on that basis, denies the same. Pantech lacks knowledge or information sufficient
16 to admit or deny the allegations of the Complaint concerning other defendants in this action, and
17 on that basis, denies the same.

18 47. Admitted as to Pantech. Pantech lacks knowledge or information sufficient to admit
19 or deny the allegations of the Complaint concerning other defendants in this action, and on that
20 basis, denies the same.

21
22 **Alleged Infringement of U.S. Patent No. 6,681,120**

23 48. Pantech admits that United States Patent No. 6,681,120 (“the ‘120 patent”) is entitled
24 “Mobile Entertainment and Communication Device” and that the ‘120 patent states on its face
25 that it issued on January 20, 2004 and is assigned to Minerva Industries, Inc. Pantech lacks

1 knowledge or information sufficient to admit or deny the remaining allegations of Paragraph 48
2 of the Complaint, and on that basis, denies the same.

3 49. Pantech admits that the '120 patent lists as inventor Ki Il KIM. Pantech lacks
4 knowledge or information sufficient to admit or deny whether Ki Il KIM is the true inventor of
5 the '120 patent.

6 50. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
7 the Complaint, and on that basis, denies the same.

8 51. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
9 the Complaint, and on that basis, denies the same.

10 52. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
11 the Complaint, and on that basis, denies the same.

12 53. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
13 the Complaint, and on that basis, denies the same.

14 54. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
15 the Complaint, and on that basis, denies the same.

16 55. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
17 the Complaint, and on that basis, denies the same.

18 56. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
19 the Complaint, and on that basis, denies the same.

20 57. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
21 the Complaint, and on that basis, denies the same.

22 58. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
23 the Complaint, and on that basis, denies the same.

24 59. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
25 the Complaint, and on that basis, denies the same.

1 60. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
2 the Complaint, and on that basis, denies the same.

3 61. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
4 the Complaint, and on that basis, denies the same.

5 62. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
6 the Complaint, and on that basis, denies the same.

7 63. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
8 the Complaint, and on that basis, denies the same.

9 64. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
10 the Complaint, and on that basis, denies the same.

11 65. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
12 the Complaint, and on that basis, denies the same.

13 66. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
14 the Complaint, and on that basis, denies the same.

15 67. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
16 the Complaint, and on that basis, denies the same.

17 68. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
18 the Complaint, and on that basis, denies the same.

19 69. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
20 the Complaint, and on that basis, denies the same.

21 70. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
22 the Complaint, and on that basis, denies the same.

23 71. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
24 the Complaint, and on that basis, denies the same.

1 72. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
2 the Complaint, and on that basis, denies the same.

3 73. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
4 the Complaint, and on that basis, denies the same.

5 74. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
6 the Complaint, and on that basis, denies the same.

7 75. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
8 the Complaint, and on that basis, denies the same.

9 76. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
10 the Complaint, and on that basis, denies the same.

11 77. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
12 the Complaint, and on that basis, denies the same.

13 78. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
14 the Complaint, and on that basis, denies the same.

15 79. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
16 the Complaint, and on that basis, denies the same.

17 80. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
18 the Complaint, and on that basis, denies the same.

19 81. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
20 the Complaint, and on that basis, denies the same.

21 82. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
22 the Complaint, and on that basis, denies the same.

23 83. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
24 the Complaint, and on that basis, denies the same.

1 84. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
2 the Complaint, and on that basis, denies the same.

3 85. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
4 the Complaint, and on that basis, denies the same.

5 86. Denied.

6 87. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
7 the Complaint, and on that basis, denies the same.

8 88. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
9 the Complaint, and on that basis, denies the same.

10 89. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
11 the Complaint, and on that basis, denies the same.

12 90. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
13 the Complaint, and on that basis, denies the same.

14 91. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
15 the Complaint, and on that basis, denies the same.

16 92. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
17 the Complaint, and on that basis, denies the same.

18 93. Pantech lacks knowledge or information sufficient to admit or deny the allegations of
19 the Complaint, and on that basis, denies the same.

20 94. Denied as to Pantech. Pantech lacks knowledge or information sufficient to admit or
21 deny the allegations of the Complaint concerning other defendants in this action, and on that
22 basis, denies the same.

23 95. Denied as to Pantech. Pantech lacks knowledge or information sufficient to admit or
24 deny the allegations of the Complaint concerning other defendants in this action, and on that
25 basis, denies the same.

1 96. Denied as to Pantech. Pantech lacks knowledge or information sufficient to admit or
2 deny the allegations of the Complaint concerning other defendants in this action, and on that
3 basis, denies the same.

4 97. Denied as to Pantech. Pantech lacks knowledge or information sufficient to admit or
5 deny the allegations of the Complaint concerning other defendants in this action, and on that
6 basis, denies the same.

7
8 **RESPONSE TO PRAYER FOR RELIEF**

9 98. Pantech denies that Minerva is entitled to any of the relief requested in its Prayer for
10 Relief.

11
12 **AFFIRMATIVE DEFENSES**

13 99. In addition to the defenses described below, Pantech expressly reserves the right to
14 allege additional defenses as they become known through the course of discovery.

15
16 **First Defense**

17 **(Non-Infringement)**

18 100. Pantech has not infringed and is not infringing any valid and enforceable claim of
19 the '120 patent, and has not induced or contributed to infringement and is not inducing or
20 contributing to infringement of any valid and enforceable claim of the '120 patent.

21
22 **Second Defense**

23 **(Invalidity)**

24 101. Each claim of the '120 patent is invalid for failing to satisfy one or more of the
25 conditions of patentability set forth in Title 35 of the United States Code, including, but not

1 limited to, 35 U.S.C. §§ 101, 102, 103, and 112.

2
3 **Third Defense**

4 **(Failure To State A Claim)**

5 102. Minerva has failed to state any claim upon which relief can be granted.

6
7 **Fourth Defense**

8 **(Statue of Limitations/Laches/Estoppel)**

9 103. Minerva's claims against Pantech are barred in whole or in part by the statute of
10 limitations, doctrine of laches, and/or equitable estoppel.

11
12 **Fifth Defense**

13 **(Limitation On Damages)**

14 104. Minerva's claims against Pantech for relief and prayer for damages are limited by 35
15 U.S.C. § 287.

16
17 **Sixth Defense**

18 **(Prosecution History Estoppel)**

19 105. Minerva is estopped from construing any claim of the patents-in-suit to cover or
20 include, either literally or by application of the doctrine of equivalents, any method or system
21 manufactured, used, imported, sold, or offered for sale by Pantech because of its actions taken,
22 and arguments made, in the United States Patent and Trademark Office during prosecution of the
23 '120 patent.

Seventh Defense

(Injunctive Relief)

106. Minerva is not entitled to injunctive relief because any alleged injury to Minerva is not immediate or irreparable, and Minerva has an adequate remedy at law.

Eighth Defense

(Patent Misuse)

107. Minerva is estopped from asserting claims relating to the '120 patent due to patent misuse in knowingly asserting against Pantech the patent-in-suit, which it knows or should know is invalid and/or not infringed and/or unenforceable.

Ninth Defense

(Unenforceability)

108. The '120 patent is unenforceable pursuant to 37 C.F.R. 1.56 and the doctrine of inequitable conduct.

COUNTERCLAIMS

The Parties

109. Pantech is a California corporation having a principal place of business in Cypress, California.

110. Minerva pleads in its Complaint that it is a corporation organized and existing under the laws of the state of California having a principal place of business in Los Angeles, California.

Jurisdiction

1 111. These counterclaims arise under Title 35 of the United States Code. The Court has
2 subject matter jurisdiction over these counterclaims pursuant to 28 U.S.C. §§ 1331, 1338(a),
3 2201, and 2202. The Court has personal jurisdiction over Minerva.
4

5 **Venue**

6 112. Venue for these counterclaims is proper in the Eastern District of Texas pursuant to
7 28 U.S.C. §§ 1391(b) and (c).
8

9 **First Counterclaim**

10 **(Declaratory Judgment of Non-Infringement)**

11 113. Pantech repeats and incorporates by reference the allegations contained in
12 paragraphs 1-112 above as if fully set forth herein.

13 114. In its Complaint, Minerva alleges that Pantech has been and is now directly and
14 indirectly infringing the '120 patent, which allegations Pantech denies.

15 115. An actual controversy exists between Pantech and Minerva regarding whether
16 Pantech has been and is now directly and indirectly infringing the '120 patent.

17 116. Pantech is entitled to judgment that Pantech has not and is not directly and indirectly
18 infringing the '120 patent.
19

20 **Second Counterclaim**

21 **(Declaratory Judgment of Invalidity)**

22 117. Pantech repeats and incorporates by reference the allegations contained in
23 paragraphs 1-112 above as if fully set forth herein.

24 118. In its Complaint, Minerva alleges that the '120 patent is legally "issued," which
25 Pantech denies.

1 119. An actual controversy exists between Pantech and Minerva concerning the validity
2 of the '120 patent.

3 120. Pantech is entitled to judgment from this Court that each claim of the '120 patent is
4 invalid pursuant to 35 U.S.C. §§ 101, 102, 103, or 112.

5
6 **Third Counterclaim**

7 **(Declaratory Judgment of Unenforceability)**

8 121. Pantech repeats and incorporates by reference the allegations contained in
9 paragraphs 1-112 above as if fully set forth herein.

10 122. Pantech is entitled to judgment from this Court that the '120 patent is void, invalid,
11 and unenforceable due to inequitable conduct in prosecuting the patent-in-suit.

12
13 **RELIEF**

14 WHEREFORE, Pantech seeks an order granting the following relief:

- 15 a. Judgment that the '120 patent, and each and every claim thereof, is not
16 infringed by Pantech, and is invalid and/or unenforceable;
- 17 b. Denial of all relief sought by Minerva and dismissal of Minerva's
18 Complaint with prejudice;
- 19 c. Pursuant to 35 U.S.C. § 285 and/or other applicable laws, a declaration that
20 this is an exceptional case and an award to Pantech of its attorneys' fees
21 and expenses incurred in connection with this action; and
- 22 d. An Order that Minerva pay costs; and
- 23 e. Such other and additional relief as this Court deems just and proper.
- 24
25

DEMAND FOR JURY TRIAL

Pantech demands trial by jury on all issues so triable.

Respectfully submitted,

Dated this 7th day of January, 2008

GILLAM & SMITH, LLP

/s/

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Wireless, Inc.

ATTORNEYS FOR DEFENDANT
PANTECH WIRELESS, INC.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this motion was served on all counsel who have consented to electronic service. Local Rule CV-5(a)(3)(A). Pursuant to Fed. R. Civ. P. 5(d) and Local Rule CV-5(e), all other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by certified mail, return receipt requested, on this 7th day of January, 2008.

/s/
Melissa R. Smith